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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/875,460
Filing Date: June 05, 2001
Appellant(s): KIKINIS, DAN

Evan M. Clark
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/12/2010 appealing from the Office action mailed 7/16/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-3, 6-11, 14-16 and 27-30 are rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

Ellis et al. (U.S. Patent Publication Application 2005/0028208) published
February 3, 2005

Ellis et al. (U.S. Patent No. 6,774,926) published August 10, 2004

Yoshida (U.S. Patent No. 5,936,611) published August 10, 1999

Dustin (U.S. Patent No. 6,853,308) published February 8, 2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claims 1-3, 6-11, 14-16 and 27-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 9 have been amended to recite, “**wherein the EPG includes an indication of which web-enabled cellular phone buttons are appropriate for the EPG**”. No support is found in the specification of the instant application for these claim limitations (**or in the provisional applications**).

Applicant notes that support for the claimed limitations are found in application 09/488,361 now Patent No. 6,421,067. The Examiner has found the section entitled "Help Mode" at Column 11, Line 25 through Column 12, Line 13. While this portion of the '067 Patent discloses an EPG that indicates which buttons on a remote control device are appropriate for performing functions for the EPG, the '067 Patent fails to teach that a web-enabled cellular phone is used as a remote control device. The Examiner further notes that the '067 Patent fails to teach that the remote control unit contains a display screen for displaying an EPG. Therefore the '067 Patent fails to provide support for the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6, 9-11, 14, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Patent Publication Application No. 2005/0028208) in view of Ellis et al. (U.S. Patent No. 6,774,926) in further view of Yoshida (U.S. Patent No. 5,936,611).

Referring to claim 1, Ellis discloses receiving EPG selection entered over the Internet via a remote device having a first video display (**see Paragraphs 0014-0016 and 0092**), wherein the EPG includes preset selections (**see Paragraph 0024**).

Ellis also discloses displaying the EPG on the first video display of the remote device (**see Paragraph 0097**).

Ellis also discloses receiving selections entered over the Internet via the remote device (**see Paragraphs 0097-0100**).

Ellis also discloses storing the EPG selections on a storage device (**see Paragraph 0072 for the remote program guide access device storing the EPG data**).

Ellis also discloses transmitting the EPG selections to be displayed on a second video display associated with a television when requested (**see Paragraph 0016 for making program selections remotely, which will be displayed on the TV**).

Ellis is silent as to the EPG selection being entered via a web-enabled cellular phone.

Ellis (**'926 Patent**) discloses a cellular phone 42 with display 100, wherein the display 100 is used to display and select EPG items (**see Column 7, Lines 18-26 and Column 8, Lines 60-67**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to combine the systems of Ellis and Ellis (**'926 Patent**) in order to provide a system capable of utilizing a mobile phone having EPG capability as a remote controller, thereby providing the user with extended functionality and control and allowing the user to reserve programs from remote locations. Also note that Ellis (**'926 Patent**) specifically states that an advantage to the system allows the cell phone to access the schedule information and perform various functions, such as searching for programming of interest, establishing favorite programs, setting reminders and setting parental controls (**see Column 1, Lines 40-46 of the '926 Ellis Patent**).

Ellis and Ellis (**'926 Patent**) are silent as to the EPG including an indication of which web-enabled cellular phone buttons are appropriate for the EPG. While Ellis (**'926 Patent**) teaches the use of a web-enabled cellular phone to make EPG selections, neither Ellis reference teaches indicating to the user which buttons can be used for a particular set of functions.

Yoshida discloses an EPG that displays an image of the remote control the viewer is using (**see Figure 7**). The remote control image on the display further provides an indication to the user each key's functionality when a user presses the key

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on the remote control (**see Figures 7-9 and Column 6, Line 30 through Column 8, Line 29**).

Further note that the Yoshida reference discloses displaying a help screen that indicates which buttons a remote control device that are appropriate for performing functions for the EPG (**see Figure 8 and Column 6, Lines 30-65 and Table 1 for when the channel up or down key is pressed, indicating that the channel up or down button is used to perform a previous or next channel selection in a channel guide/EPG**).

At the time the invention was made, it would have obvious to a person of ordinary skill in the art, to modify the EPG accessed by a web-enabled cellular phone, as taught by Ellis and Ellis (**'926 Patent**), using the instructional control keys interface, as taught by Yoshida, for the purpose of allowing a user to easily know the function of the keys even through he/she loses or misplaces the manual for the device (**see Column 2, Lines 55-57 of Yoshida**).

Referring to claims 2 and 3, Ellis discloses storing EPG selections on a broadcast server and set top box (**see Paragraph 0017 and Figure 2**).

Referring to claim 6, Ellis further discloses that the system displays EPG selection on the remote terminal when requested (**see Paragraph 0015**).

Referring to claims 9-11 and 14, see the rejection of claims 1-3 and 6, respectively. In regards to claim 9, further note that Ellis discloses that the EPG can also be displayed on the second video display associated with the television (**see Paragraph 0071**).

Referring to claim 28, Yoshida further discloses displaying an indication in the EPG for which buttons are appropriate (**see Figure 8 and Column 6, Lines 30-65 and Table 1 for when the channel up or down key is pressed, indicating that the channel up or down button is used to perform a previous or next channel selection in a channel guide/EPG**).

Referring to claim 30, see the rejection of claim 28.

Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Patent Publication Application No. 2005/0028208) in view of Ellis et al. (U.S. Patent No. 6,774,926) in further view of Yoshida (U.S. Patent No. 5,936,611) in further view of Cooper et al. (U.S. Patent No. 6,754,904).

Referring to claim 7, Ellis, Ellis (**'926 Patent**) and Yoshida disclose all of the limitations of claim 6, where Ellis (**'926 Patent**) teaches the use of a web-enabled cellular phone in place of a remote control to select television programs in an EPG (**see**

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above), but are silent as to transmitting the EPG selections over the Internet to multiple web-enabled cellular phones to be displayed concurrently when requested.

Cooper discloses a plurality of client devices that are capable of selecting television programs to view (**see Figure 5**). Cooper further discloses making EPG selection (**see Figure 7 for using the EPG of Figure 6**) and transmitting the selections over the Internet to multiple client devices to be displayed to all users (**concurrently**) while in a chat room (**see Figures 7-11 and Column 2, Lines 45-47 and Column 5, Line 54 through Column 7, Line 59**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the web-enabled cellular phones, as taught by Ellis, Ellis ('**926 Patent**) and Yoshida, using the chat enabled client devices, as taught by Yoshida, for the purpose of informing a first network user of activity by other network users, thereby allowing users to know what television programs his/her friends are watching (**see Column 2, Lines 39-41 of Cooper**).

Referring to claim 15, see the rejection of claim 7.

Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Patent Publication Application No. 2005/0028208) in view of Ellis et al. (U.S. Patent No. 6,774,926) in further view of Yoshida (U.S. Patent No. 5,936,611) in further view of Terakado et al. (U.S. Patent No. 6,246,441).

Referring to claim 8, Ellis and Ellis ('926 Patent) disclose all of the limitations of claim 6, but are silent as to transmitting one or more programs to be separately displayed concurrently with displaying the EPG selections.

Terakado discloses (**in the same field of endeavor**) a similar system which is capable of allowing a user to view a program broadcast on the television while concurrently viewing the EPG data on the remote terminal (**see Column 9, Lines 47-53**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the systems of Ellis, Ellis (**'926 Patent**) and Yoshida, using the teachings of Terakado in order to provide a system capable of allowing a user to watch a broadcast program on the television receiver 9, while checking programs to be broadcast from a time onward by using an EPG without obstructing the display of the television receiver 9 (**see Column 9, Lines 50-53 of Terakado**).

Referring to claim 16, see the rejection of claim 8.

Claims 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (U.S. Patent Publication Application No. 2005/0028208) in view of Ellis et al. (U.S. Patent No. 6,774,926) in further view of Yoshida (U.S. Patent No. 5,936,611) in further view of Dustin (U.S. Patent No. 6,853,308).

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Referring to claim 27, Ellis, Ellis and Yoshida disclose all of the limitations of claim 1, but fail to teach illuminating LEDs corresponding to the appropriate buttons.

Dustin discloses a "Light" Button that illuminates buttons on a remote control (see Column 4, Lines 6-8).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the web-enabled cellular phone, as taught by Ellis, Ellis and Yoshida, using the illuminated buttons, as taught by Dustin, for the purpose of allowing a user to operate the remote control/web-enabled cellular phone in a darkened room (see Column 4, Lines 7-8 of Dustin).

Referring to claim 29, see the rejection of claim 27.

(10) Response to Argument

I. Rejection under U.S.C. § 112, First Paragraph

In regards to the 112 1st Paragraph rejection, Applicant notes that support for the claimed limitations are found in application 09/488,361 now Patent No. 6,421,067. The Examiner has found the section entitled "Help Mode" at Column 11, Line 25 through Column 12, Line 13. While this portion of the '067 Patent discloses an EPG that indicates which buttons on a remote control device are appropriate for performing

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functions for the EPG, the '067 Patent fails to teach that a web-enabled cellular phone is used as a remote control device. The Examiner further notes that the '067 Patent fails to teach that the remote control unit contains a display screen for displaying an EPG. Therefore the '067 Patent fails to provide support for the claims.

Applicant specifically states that “**one skilled in the art will appreciate that hand held unit 220 of Figure 2 COULD be web-enabled phone and that such devices contain a display screen large enough to allow for an EPG to be displayed therein**”. The Examiner notes that hand held unit 220 could be any type of portable device, however the specification fails to teach that the hand held unit 220 **is** a web-enabled phone.

II. Rejection under U.S.C. § 103(A)

A. Independent Claims 1 and 9

Applicant argues that Yoshida fails to teach or suggest indicating which buttons are appropriate for performing functions for the EPG. The Examiner respectfully disagrees.

The Ellis '208 Publication and Ellis '926 Patent teach a web-enabled cellular phone that displays a program guide while the Yoshida reference discloses displaying a help screen that indicates which buttons a remote control device that are appropriate for performing functions for the EPG (**see Figure 8 and Column 6, Lines 30-65 and Table**

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1 for when the channel up or down key is pressed, indicating that the channel up or down button is used to perform a previous or next channel selection in a channel guide/EPG). Specifically Table 1 clearly teaches that the description for explaining functions on a remote control include that the channel up and channel down button displays a message stating "**GO TO THE NEXT CHANNEL WHEN TUNING AND IN CH. GUIDE**". Therefore Yoshida clearly teaches indicating which buttons are appropriate for performing functions for the EPG.

B. Dependent Claims 27 and 29

Applicant argues that Dustin does not teach or suggest "**wherein indicating which buttons on the web-enabled cellular phone are appropriate includes illuminating LEDs corresponding to the appropriate buttons**". The Examiner respectfully disagrees.

Yoshida teaches indicating which button is appropriate for controlling the EPG, while Dustin teaches allowing a user to illuminate the lights on the remote controller (**see column 4, Lines 6-8**). Therefore, by allowing Yoshida to illuminate the buttons on the remote control indicating which buttons are appropriate to control the EPG, Yoshida would be permitted to operate the remote control/web-enabled cellular phone in a darkened room (**see Column 4, Lines 7-8 of Dustin**).

C. Dependent Claims 2, 3, 6-8, 10, 11, 14-16, 28 and 30

Referring to claims 2, 3, 6-8, 10, 11, 14-16, 28 and 30, see the Examiner's rebuttal above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jason Salce

/Jason P Salce/

Primary Examiner, Art Unit 2421

May 5, 2010

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